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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,948	11/14/2005	Martine Seu-Salerno	085516-9004-00	2392
23409 7590 03/01/2011 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER SHIRENGARTS, SAMANTHA L				
ART UNIT		PAPER NUMBER		
1626				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/527,948

**Applicant(s)**

SEU-SALERNO ET AL.

**Examiner**

Samantha L. Shterengarts

**Art Unit**

1626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-912)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

1. Applicant's amendment filed 12/15/2010 have been received and entered into the present application.
2. Applicant's arguments filed 12/15/2010 have been fully considered. Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.
3. Claims 13-20 are currently under examination and the subject matter of the present Office Action.

**Claim Rejections - 35 USC § 112**

4. Claims 13-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 has been amended to recite "provided that the particles have a hydrophobic surface nature when the liquid phase is aqueous and provided that the particles have a lipophobic surface when the liquid phase is oil-based." The above limitation is not clear. It is not understood how the same particles can in one instance be hydrophobic and in the other instance be lipophobic. Clarification is requested.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 13, 16 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated Sakai et al. (U.S. 2002/0034525).

Sakai et al. teaches a skin cosmetic composition comprising an oil component dispersed in an aqueous medium (abstract). The skin cosmetic composition has excellent utility, which gives sufficient moisturizing effects while being free from tackiness and having a refreshing feeling (paragraph [0002]). The aqueous cosmetic composition having a double-layer form comprising an aqueous phase and an oil phase separated from each other is excellent in moisturizing effects (paragraph [0008]). The composition contains inorganic particles such as mica and titanium oxide and aqueous polymers such as carboxymethyl modified starch (paragraphs [0084] and [0097]).

Though Sakai et al. is silent as to the effect of the composition to transform into a cream upon application, the composition is expected to necessarily have the claimed effect of transforming into a cream whether recognized by the author or not, absent evidence to the contrary. Products of identical chemical composition cannot exert mutually exclusive properties when administered under the same circumstance or, in the present case, the same host. Please reference MPEP 2112.

6. Claims 13, 16 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (U.S. 5,645,903; previously made of record).

Tanaka et al. teaches a cosmetic composition made up in whole or in part of a solid powder, the composition comprising a liquid phase in encapsulated form or immobilized on the surface of a solid, a gelling agent (agar or gelatin) for the liquid phase and mineral or organic particles having surface properties that give the particles a low affinity for the liquid phase (column 2, lines 41-49; column 3, lines 26-49).

Though Tanaka et al. is silent as to the effect of the composition to transform into a cream upon application, the composition is expected to necessarily have the claimed effect of transforming into a cream whether recognized by the author or not, absent evidence to the contrary. Products of identical chemical composition cannot exert mutually exclusive properties when administered under the same circumstance or, in the present case, the same host. Please reference MPEP 2112.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al. (U.S. 2002/0034525) in view of Ohno et al. (U.S. 5,023,065; previously made of record).

Ohno et al. teaches that it is well known in the art to use fluorinated mica modified with potassium in a powder foundation (Example 1). Specifically, use fluorinated mica modified with potassium improves extensibility, adherence and moldability of the cosmetic (column 1, lines 18-20 and column 29, lines 37-46).

It would have been obvious to one of ordinary skill in the art to use fluorinated mica modified with potassium of Ohno et al. in the cosmetic of Sakai et al.. One would have been motivated to do so in order to improve the extensibility, adherence and moldability of the cosmetics, per Ohno et al. Further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Though Sakai et al. is silent as to the effect of the composition to transform into a cream upon application, the composition is expected to necessarily have the claimed effect of transforming into a cream whether recognized by the author or not, absent evidence to the contrary. Products of identical chemical composition cannot exert mutually exclusive properties when administered under the same circumstance or, in the present case, the same host. Please reference MPEP 2112.

8. Claims 13-14, 16 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (U.S. 5,645,903; previously made of record) in view of Funatsu et al. (U.S. 5,622,693; previously made of record).

Tanaka et al. teaches a cosmetic composition made up in whole or in part of a solid powder, the composition comprising a liquid phase in encapsulated form or immobilized on the surface of a solid, a gelling agent (agar or gelatin) for the liquid phase and mineral or organic particles having surface properties that give the particles a low affinity for the liquid phase (column 2, lines 41-49; column 3, lines 26-49). Further, Tanaka et al. teaches that the mineral particles comprise fluorinated titanium dioxide particles (Table 1). Finally, Tanaka et al. discloses the cosmetic composition is a water based composition (column 3, lines 19-20 and column 5, lines 18-20).

Tanaka et al. is silent on starch modified by carboxymethyl groups as the gelling agent.

Funatsu et al. teaches that both gelatin and carboxymethyl starch are known as gelling agents (column 2, lines 21-56).

One of ordinary skill in the art would have found it prima facie obvious to use starch modified carboxymethyl groups as a gelling agent in solid cosmetic compositions. One would have been motivated to do so because it is known in the art that both gelatin and carboxymethyl modified starch, respectively, are known as gelling agents, per Funatsu et al. Thus, one would have been motivated do substitute gelatin for carboxymethyl modified starch. Finally, it would have been obvious to one of ordinary skill in the art to modify the type of gelling agent used,

since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Though Tanaka et al. is silent as to the effect of the composition to transform into a cream upon application, the composition is expected to necessarily have the claimed effect of transforming into a cream whether recognized by the author or not, absent evidence to the contrary. Products of identical chemical composition cannot exert mutually exclusive properties when administered under the same circumstance or, in the present case, the same host. Please reference MPEP 2112.

9. Claims 13, 15, 16-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (U.S. 5,645,903; previously made of record) in view of Yamamoto et al. (U.S. 6,548,454; previously made of record).

Tanaka et al. teaches a cosmetic composition made up in whole or in part of a solid powder, the composition comprising a liquid phase in encapsulated form or immobilized on the surface of a solid, a gelling agent (agar or gelatin) for the liquid phase and mineral or organic particles having surface properties that give the particles a low affinity for the liquid phase (column 2, lines 41-49; column 3, lines 26-49). Further, Tanaka et al. teaches that the mineral particles comprise fluorinated titanium dioxide particles (Table 1). Finally, Tanaka et al. discloses the cosmetic composition is a water based composition (column 3, lines 19-20 and column 5, lines 18-20).

Tanaka et al. is silent on the use of fluorinated mica for its use as a gelling agent.



Yamamoto et al. teaches that fluorinated mica is known to be used as a gelling agent (claim 1).

One of ordinary skill in the art would have found it prima facie obvious to use fluorinated mica as a gelling agent in solid cosmetic compositions. One would have been motivated to do so because it is known in the art that both gelatin and fluorinated mica, respectively, are known as gelling agents, per Yamamoto et al. Thus, one would have been motivated to substitute gelatin for fluorinated mica. Finally, it would have been obvious to one of ordinary skill in the art to modify the type of gelling agent used, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Though Tanaka et al. is silent as to the effect of the composition to transform into a cream upon application, the composition is expected to necessarily have the claimed effect of transforming into a cream whether recognized by the author or not, absent evidence to the contrary. Products of identical chemical composition cannot exert mutually exclusive properties when administered under the same circumstance or, in the present case, the same host. Please reference MPEP 2112.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (U.S. 5,645,903; previously made of record) in view of Yamamoto et al. (U.S. 6,548,454; previously made of record) as applied to claims 13, 15, 16-17 and 19-20 above, and further in view of Ohno et al. (U.S. 5,023,065; previously made of record).

The combination of Tanaka et al. (U.S. 5,645,903; previously made of record) in view of Yamamoto et al. (U.S. 6,548,454; previously made of record). The combination is silent on the fluorinated mica being modified with potassium.

Ohno et al. teaches that it is well known in the art to use fluorinated mica modified with potassium in a powder foundation (Example 1). Specifically, use fluorinated mica modified with potassium improves extensibility, adherence and moldability of the cosmetic (column 1, lines 18-20 and column 29, lines 37-46).

It would have been obvious to one of ordinary skill in the art to use fluorinated mica modified with potassium of Ohno et al. in the cosmetic of Tanaka et al. in view of Yamamoto et al. One would have been motivated to do so in order to improve the extensibility, adherence and moldability of the cosmetics, per Ohno et al. Further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### **Conclusion**

11. No claim is found to be allowable.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samantha Shterengarts whose telephone number is (571)270-5316. The examiner can normally be reached on Monday thru Thursday 9-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samantha L. Shtengarts/  
Examiner, Art Unit 1626

/Kamal A Saeed/  
Primary Examiner, Art Unit 1626